

REMARKS/ARGUMENTS

Claims 1-4, 6-9 and 12-18 are pending in the application. Claims 9, 12 and 13 are rejected. Claims 17 and 18 are withdrawn from consideration. Claims 5, 10, 11 and 12 have been canceled. Claims 9 and 13 have been amended. Claims 1-4, 6-8 and 14-16 have been allowed.

Amendments

Claim 9 was amended to remove the redundant formulas and add commas and other grammatical corrections. No new matter was added by this amendment. Accordingly, applicants respectfully request entry of this amendment.

Claim 13 was amended to clarify and distinctly claim the subject matter, which applicants regarded as their invention. No new matter was added by this amendment. Accordingly applicants respectfully request entry of this amendment.

Rejection under 35 U.S.C. §112, second paragraph

1. Claim 12 has been rejected under 35 U.S.C. § 112 second paragraph, because it is alleged to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as their invention and 35 U.S.C §112 first paragraph, as not being enabled. Although applicants do not agree with these grounds of rejection for claim 12 and believe the claim is definite and is enabled, claim 12 has been canceled to expedite prosecution. Applicants reserve the right to present this claim in a subsequent application. However, in view of the cancellation of this claim applicants' attorney respectfully submits that the rejection of claim 12 is moot and requests withdrawal of this rejection.

2. Claims 9, has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. It appears the examiner believed that a "4" is

missing from in front of the R/S configurations. However, applicants' attorney requests reconsideration and further explanation of this rejection.

The first compounds disclosed on page 9, [2R-trans, R*]-(2-benzyl-4-{4-[1-(furan-3-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-(3,5-bis-trifluoromethyl-phenyl)-methanone, corresponds to compound number 32 from the application, which appears on page 74, in Table 1. The stereocenters are indicated in the drawing of the generic structures compounds provided as a part of Table 1. Applicants attorney respectfully submit that one of ordinary skill in the art would understand the structure of the claimed compounds without the addition of any additional clarifications. Additionally the tables in the specification indicates where the stereocenters occur and following the disclosure in the specification and the nomenclature used in the specification, if an additional numbers were to be added to the stereo comment the compound would be designated as [2R-trans, 3'R*]-(2-benzyl-4-{4-[1-(furan-3-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-(3,5-bis-trifluoromethyl-phenyl)-methanone. The third compounds disclosed on page 10, [(2R-trans),(S)]-1-(3-{4-[1-(3,5-bis-trifluoromethyl-benzoyl)-2-(3,4-dichloro-benzyl)-piperidin-4-yl]-piperazin-1-yl}-pyrrolidin-1-yl)-2,2-dimethyl-propan-1-one, corresponds to compound number 313 from the application, which appears on page 90, in Table 4. This compound following the nomenclature suggested by the examiner would be [(2R-trans),3'(S)]-1-(3-{4-[1-(3,5-bis-trifluoromethyl-benzoyl)-2-(3,4-dichloro-benzyl)-piperidin-4-yl]-piperazin-1-yl}-pyrrolidin-1-yl)-2,2-dimethyl-propan-1-one. Similarly the compounds on pages 11 and 12 with similar results could be renamed as:

[(2R-trans),3'(S)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(thiophene-2-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone,

[(2R-trans),3'(R)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(thiophene-3-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone,

[(2R-trans),3'(R)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(furan-2-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone₂

[(2R-trans),3'(S)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(furan-2-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone₂
 [(2R-trans),3'(S),3''(R)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(tetrahydro-furan-3-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone₂

[(2R-trans),3'(R)]-(3,5-bis-trifluoromethyl-phenyl)-(2-(3,4-dichloro-benzyl)-4-{4-[1-(pyrazine-2-carbonyl)-pyrrolidin-3-yl]-piperazin-1-yl}-piperidin-1-yl)-methanone₂

Applicants' attorney respectfully submits that the addition of the 3' and 3'' to these formulas is unnecessary in view of the specification. Accordingly, applicants' attorney respectfully submits that one of skilled in the art would understand the meaning of the chemical formulas without further amendment to the nomenclature. Therefore, applicants' attorney respectfully requests reconsideration and withdrawal of the rejection of claims 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

To expedite prosecution applicants' attorney has removed the formulas that only provided graphical representation of the written chemical formulas as well as added commas between the formulas and added an "and" before the last compound.

3. The rejection of Claim 13 under 35 U.S.C §112, second paragraph, has been reviewed. However, in view of the amendments to claim 13 it is respectfully submitted that this rejection is now moot. Accordingly, reconsideration and withdrawal of the rejection of claim 13 is requested.

Rejection under 35 U.S.C. §112, first paragraph

4. Claim 9 has been rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The claims have been alleged to contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor possessed the invention at the time the application was filed. Applicants however respectfully requests reconsideration and withdrawal of this rejection.

Claim 9 is regarded as being incomplete as written since it relies on the specification to define the claimed subject matter. By the previous amendment claim 9 was amended by deleting the compound numbers and inserting the name and structure of 28 compounds falling within the scope of claim 1 as amended. The 28 compounds correspond to compound numbers 4, 306, 71, 72, 31, 219, 218, 32, 321, 308, 393, 313, 164, 318, 287, 267, 317, 331, 286, 366, 269, 281, 285, 270, 258, 259, 253 and 408 all of which are disclosed in Tables 1, 4, 5 and 6 in the specification.

Support for the first compound in claim 9 can be found on page 66, in Table 1 as compound 4.

Support for the second compound in claim 9 can be found on page 68, Table 1 as compound 306.

Support for the third compound in claim 9 can be found on page 68, Table 1 as compound 71.

Support for the fourth compound in claim 9 can be found on page 68, Table 1 as compound 72.

Support for the fifth compound in claim 9 can be found on page 74, line Table 1 as compound 31.

Support for the sixth compound in claim 9 can be found on page 74, line Table 1 as compound 219.

Support for the seventh compound in claim 9 can be found on page 74, Table 1 as compound 218.

Support for the eighth compound in claim 9 can be found on page 74, Table 1 as compound 32.

Support for the ninth compound in claim 9 can be found on page 75, Table 1 as compound 321.

Support for the tenth compound in claim 9 can be found on page 83, Table 1 as compound 308.

Support for the eleventh compound in claim 9 can be found on page 89, Table 4 as compound 393.

Support for the twelfth compound in claim 9 can be found on page 40, Table 4 as compound 313.

Support for the thirteenth compound in claim 9 can be found on page 90, Table 4, as compound 164.

Support for the fourteenth compound in claim 9 can be found on page 91, Table 4, as compound 318.

Support for the fifteenth compound in claim 9 can be found on page 91, Table 4, as compound 287.

Support for the sixteenth compound in claim 9 can be found on page 91, Table 4,

as compound 267.

Support for the seventeenth compound in claim 9 can be found on page 91, in Table 4, as compound 317.

Support for the eighteenth compound in claim 9 (331) can be found on page 92, in Table 4, as compound 331.

Support for the nineteenth compound in claim 9 can be found on page 92, in Table 4, as compound 286.

Support for the twentieth compound in claim 9 can be found on page 94, in Table 5, as compound 366.

Support for the twenty-first compound in claim 9 can be found on page 94, in Table 5, as compound 269.

Support for the twenty-second compound in claim 9 can be found on page 94, Table 5, as compound 281.

Support for the twenty-third compound in claim 9 can be found on page 94, Table 5, as compound 285.

Support for the twenty-fourth compound in claim 9 can be found on page 94, Table 5, as compound 270.

Support for the twenty-fifth compound in claim 9 can be found on page 95, Table 5, as compound 258.

Support for the twenty-sixth compound in claim 9 can be found on page 95, Table 5, as compound 259.

Support for the twenty-seventh compound in claim 9 can be found on page 95, Table 5, as compound 253.

Support for the twenty-eighth compound in claim 9 can be found on page 97, Table 6, as compound 408.

Accordingly applicants respectfully submit that claim 9 complies with the written description requirement and requests withdrawal of this rejection.

5. Claim 12 has been rejected under 35 U.S.C §112, first paragraph, as allegedly not being enabled. Although applicants do not agree with the grounds of rejection for claim 12 and believe the claim is enabled, claim 12 has been canceled to expedite prosecution. Applicants reserve the right to present this claim in a subsequent application. However, in view of the cancellation of this claim applicants' attorney respectfully submits that the rejection of claim 12 is moot and requests withdrawal of this rejection.

Conclusion

The Commissioner is hereby authorized to charge any deficiency or credit any overpayments necessitated by this Amendment to Deposit Account No. 10-0750/JAB1731USNP/HBW.

Early favorable action on the merits is respectfully requested. Applicant respectfully requests that a timely Notice of Allowance of claims 1-4, 6-8 and 13-16.

Respectfully submitted,

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